

wide opening, the narrow opening being connected to the first opening, said method comprising the steps of:

positioning a receptacle over an exterior surface of the tube section adjacent the second opening;

inserting the item within the flared section via the wide opening; and

sliding the item through the narrow opening of the flared section, through the tube section, and within the receptacle,

wherein said method further comprises the step of rotating the item as the item is slid through the tube section.

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#### REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1 and 3-8 are presently active in this case, Claims 1, 3, and 4 having been amended and Claims 2 and 9-19 having been canceled by way of the present Amendment.

In the outstanding Official Action, Claims 1, 5-6, 8-9, 13-17, and 19 were rejected under 35 U.S.C. 102(b) as being anticipated by Chapuis (U.S. Patent No. 3,658,273). Claims 2-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chapuis in view of Biddle et al. (U.S. Patent No. 5,870,885). Claims 7, 10-12, and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chapuis. For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

The cancellation of Claims 9-19 renders the rejections thereof moot. The subject matter of Claim 2 has been incorporated into independent Claim 1, and Claims 3 and 4 have been rewritten in independent form. Accordingly, the obviousness rejection based upon the

combination of the Chapuis reference and the Biddle et al. reference is the sole remaining rejection at issue.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness has not been established in the present case because the references, either taken singularly or in combination, do not teach or suggest all of the claim limitations, and because there is no motivation to combine the Chapuis and Biddle et al. references.

Independent Claims 1, 3, and 4 of the present application recite a method for inserting an item that is a rolled, elongated sheet of material into a receptacle using an apparatus having a hollow tube section having a first opening and a second opening and a hollow flared section having a narrow opening and a wide opening, where the narrow opening is connected to the first opening. The method comprising the steps of positioning a receptacle over an exterior surface of the tube section adjacent the second opening, inserting the item within the flared section via the wide opening, and sliding the item through the narrow opening of the flared section, through the tube section, and within the receptacle. Claims 1 and 3 recite a step of rotating the rolled item as the rolled item is inserted within the flared section. Claim 4 recites a step of rotating the rolled item as the rolled item is slid through the tube section

The Applicants submit that neither the Chapuis reference, nor the Biddle et al. reference disclose or suggest a method of inserting an item into a receptacle including a step of rotating the rolled item as the rolled item is inserted within a flared section of an apparatus,

as recited in Claims 1 and 3 of the present application. Furthermore, the Applicants submit that neither the Chapuis reference, nor the Biddle et al. reference disclose or suggest a method of inserting an item into a receptacle including a step of rotating the rolled item as the rolled item is slid through a tube section of an apparatus, as recited in Claim 4 of the present application.

The Chapuis reference describes a side (44) of a machine having an opening (45) equipped with a funnel (46) which is slightly frusto-conical, as depicted in Figure 5. The Applicants note that the Chapuis reference does not disclose an apparatus having both a hollow tube section and a hollow flared section, where a receptacle is positioned over an exterior surface of the tube section as expressly recited in Claims 1, 3, and 4. The structure described in the Chapuis reference has a single funnel (46) section. The Applicants further note that the Biddle et al. reference does not supplement the deficiency in the teaching of the Chapuis reference.

The Official Action notes that the Chapuis reference does not teach rotating the item as it passes through the hollow tube. The Biddle et al. reference is cited for the teaching of such a step. However, the Biddle et al. reference is directed to an apparatus and method for inserting and positioning a compressible foam material into a container in the medical arts. The methods described therein are configured for use with foam inserts that are not rolled items, as in the present application. No suggestion is made in the Biddle et al. reference of the use of the methods described therein with rolled, elongated sheets of material. The Biddle et al. reference describes with specificity the structure of the foam plugs and does not disclose or suggest the use of a rolled, elongated sheet of material. (See column 7, lines 3-25.) The Biddle et al. reference describes the essential need for the predictability of the permeability of the foam stopper, however the use of a rolled item would not be as homogeneous in nature as

a foam plug and therefore would not be a predictable in terms of permeability. Accordingly, one of skill in the art would not have been motivated to combine the teachings of the Biddle et al. reference with the teachings of the Chapuis reference.

Additionally, the Chapuis reference describes an automated device for inserting the item into a carton (47). (See Figure 5 of the Chapuis reference.) The Chapuis reference does not teach the rotation of the item during insertion of the item into the carton (47), as noted in the Official Action. The Biddle et al. reference also describes an automated insertion device that does not use a twisting action as a means of inserting the foam. (See column 24, lines 34-35, of the Biddle et al. reference.) Accordingly, even if these teachings are combined, the combination of these embodiments does not provide one of skill in the art with a motivation to rotate the item during insertion.

The Applicants, therefore, respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Claims 5-8 are considered allowable for the reasons advanced for Claim 1 from which they depend. These claims are further considered allowable as they recite other features of

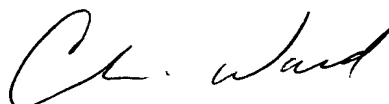
the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 1.

Accordingly, the Applicants respectfully request the withdrawal of the art rejections.

Consequently, in view of the above discussion, it is respectfully submitted that the pending claims are patentably distinguishing over the cited art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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IN THE CLAIMS

Please cancel Claims 2, 9-19 without prejudice or disclaimer.

Please amend Claims 1, 3, and 4 as follows:

1. (Once Amended) A method for inserting an item into a receptacle using an apparatus having a hollow tube section having a first opening and a second opening and a hollow flared section having a narrow opening and a wide opening, the narrow opening being connected to the first opening, said method comprising the steps of:

positioning a receptacle over an exterior surface of the tube section adjacent the second opening;

inserting the item within the flared section via the wide opening; and

sliding the item through the narrow opening of the flared section, through the tube section, and within the receptacle,

wherein the item is a rolled, elongated sheet of material that is rolled such that a terminal edge of the elongated sheet is located on an exterior surface of the rolled item, and

wherein said method further comprises the step of rotating the item as the item is inserted within the flared section, where the item is rotated in a direction opposite a direction of rolling of the item such that the terminal edge of the elongated sheet is maintained flat against the exterior surface of the rolled item.

3. (Once Amended) [The method according to Claim 1] A method for inserting an item that is a rolled, elongated sheet of material into a receptacle using an apparatus having a

hollow tube section having a first opening and a second opening and a hollow flared section having a narrow opening and a wide opening, the narrow opening being connected to the first opening, said method comprising the steps of:

positioning a receptacle over an exterior surface of the tube section adjacent the second opening;

inserting the item within the flared section via the wide opening; and

sliding the item through the narrow opening of the flared section, through the tube section, and within the receptacle,

wherein said method further comprises the step of rotating the item as the item is inserted within the flared section.

4. (Once Amended) [The method according to Claim 1] A method for inserting an item that is a rolled, elongated sheet of material into a receptacle using an apparatus having a hollow tube section having a first opening and a second opening and a hollow flared section having a narrow opening and a wide opening, the narrow opening being connected to the first opening, said method comprising the steps of:

positioning a receptacle over an exterior surface of the tube section adjacent the second opening;

inserting the item within the flared section via the wide opening; and

sliding the item through the narrow opening of the flared section, through the tube section, and within the receptacle,

wherein said method further comprises the step of rotating the item as the item is slid through the tube section.